

Application No.: 10/051,976

2

Docket No.: 282172000902

REMARKS

Claims 1-24 and 27-59 are pending in the instant application prior to amendment. Claims 25-26 were cancelled previously, and various claims as discussed above have been amended. Claims 10-24 and 27-54 have been withdrawn from consideration on the basis that they are drawn to a non-elected invention, and claims 1-9 and 55-59 therefore stand rejected on various grounds. The objections and rejections are addressed in the appropriate sections below.

The present application is in condition for allowance.

35 U.S.C. § 103(a)

Claims 1-9 and 55-59 stand rejected under 35 U.S.C. § 103 as being allegedly obvious over Wollowitz et al. (U.S. Pat. No. 5,593,823) in view of Tsyurupa et al. and Davankov et al. Applicants respectfully traverse the rejection.

Applicants previously submitted a Rule 132 Declaration by Derek J. Hei establishing that Mr. Hei is the sole inventor of the subject matter disclosed at col. 53 lines 43-63 of Wollowitz et al. The Examiner stated that Mr. Hei's "mere statement of being a sole inventor of the subject matter as in the declaration is not enough."

MPEP 716.10 states that "[a]n uncontradicted 'unequivocal statement' from the applicant regarding the subject matter disclosed in an article, patent, or published application will be accepted as establishing inventorship. *In re. DeBaun*, 687 F.2d 459, 463, 214 USPQ 933, 936 (CCPA 1982)." Because such a statement will be accepted as establishing inventorship, Applicants submit that Mr. Hei's inventorship is established. Should the Examiner disagree, Applicants request that the Examiner specify what information the Examiner believes needs to be submitted to aid in resolving the issue.

The Examiner also stated that Applicants have not pointed out on which dependent claims Mr. Cimino is an inventor. Applicants submit that this information is irrelevant on the issue

pa-921137

Application No.: 10/051,976

3

Docket No.: 282172000902

of whether the cited reference qualifies as prior art against the present application for a rejection under 35 U.S.C. Sec. 103(a).

35 U.S.C. Sec. 103(c) states that "[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability ... where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." The rejection addressed above is one made under 35 U.S.C. Sec. 103(a), and as explained in the Amendment accompanying the RCE, the only subsections of 35 U.S.C. Sec. 102 under which the Wollowitz et al. patent might qualify are subsections (e), (f), and (g). 35 U.S.C. Sec. 103(c) therefore precludes the use of Wollowitz et al. in rejecting the claims for the reasons above and for the reasons stated in the previous Amendment.

Obviousness-Type Double Patenting Rejection

Claims 1-9 and 55-59 stand rejected under the judicially created doctrine of double patenting to claims 1-47 of U.S. Patent No. 6,544,727 B1. Applicants submit that this rejection is improper, since the Office restricted claims drawn to a device from claims drawn to a method in an Office Action mailed July 9, 1999 for parent application 08/660,910. Applicants therefore request withdrawal of the rejection.

Provisional Obviousness-Type Double Patenting Rejection

Claims 1-9 and 55-59 stand provisionally rejected under the judicially created doctrine of double patenting to claims 53-110 of copending U.S. Patent Application No. 09/972,323 or claims 53-115 of copending Application No. 10/011,202 or claims 1-24 of copending Application No. 09/872,384.

Applicants note the provisional nature of this rejection and submit that they will address any issues with these applications upon an indication of otherwise-allowable subject matter.

pa-921137

Application No.: 10/051,976

4

Docket No.: 282172000902

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 282172000902. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

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Respectfully submitted,

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pa-921137